

Applicant : Alexander Hilscher et al
Serial No. : 10/662,237
Filed : September 15, 2003
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Attorney's Docket No.: 02894-609001 / 06410-PT12/co-

REMARKS

Applicants note that the amendments to the specification, with the exception of the amendment made to page 1, line 1, are the same as the amendments made in the Preliminary Amendment filed on September 15, 2003, except that the page and line numbers have been corrected to correct erroneous page and line numbers. Applicants offer to submit a substitute specification if desired by the patent office.

In response to the restriction requirement mailed on April 24, 2004, applicants elected the Group II claims to a handle section/cleaning device and did not elect method claims. In the restriction requirement mailed on May 25, 2004, applicants were requested to, in addition, elect one of the device species that had been identified in the original restriction requirement. The species identification erroneously identified Figs. 18 and 19 as involving a separate embodiment from Fig. 20; however, the specification makes it clear at page 18, line 30 to page 19, line 15 that "FIGS. 18-20 illustrate a further embodiment of the invention".

Response to Restriction Requirement

In response to the restriction requirement, applicants elect the embodiment of Figs. 18-20. Applicants have replaced the original device claims 4-41 with new device claims 42-59, all of which read on the elected species of Figs. 18-20.

Pursuant to 37 CFR 1.604(b), applicants advise that new claims 42-59 herein have been copied or substantially copied from claims 1-2, 4-8, 10, 11, 13-16, and 19-22 of US 2003/0115694, published on June 26, 2003, which is U.S. Application No. 10/029,336. Claims 42 and 53 herein are independent and are identical to independent claims 1 and 14 of US 2003/0115694.

Independent claims 42 and 53 have already effectively been found to be patentable to applicants herein over the prior art by Examiner Spisich in the prosecution of US 2003/0115694.

In an office action dated February 9, 2004 in U.S. Application No. 10/029,336 (copy enclosed as **Exh. A**), independent claims 1 and 14 were rejected as anticipated by Hilscher US 2002/129454, but otherwise were not rejected on the prior art. Hilscher US 2002/129454 is commonly assigned with present application and has a filing date of March 16, 2001, such that it

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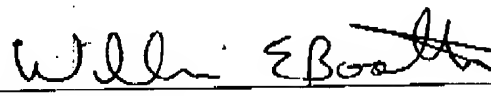
is not prior art against this application, which has an effective filing date of March 14, 2001. Also, both Hilscher US 2002/129454 and this application have the same relevant Figs. 18-20 and corresponding text (page 18, line 30 to page 19, line 15 herein and ¶90 in Hilscher US 2002/129454; see relevant pages enclosed as **Exh. B**) with respect to the subject matter of independent claims 1 and 14 of US2003/0115694, such that Examiner Spisich has effectively already determined that independent claims 42 and 53 herein are supported by the specification herein. (The claims herein are also supported by the discussion of the radio device embodiment at page 9, lines 10-21 of this application.) Because Hilscher US 2002/129454 was the only prior art that was cited against this claimed subject matter, and that reference is not prior art against this application, these claims are patentable herein.

Applicants submit that all claims are in condition for allowance, and such allowance is respectfully solicited.

Please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: June 18, 2004


William E. Booth
Reg. No. 28,933

Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110-2804
Telephone: (617) 542-5070
Facsimile: (617) 542-8906

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Office Action Summary	Application No.	Applicant(s)	
	10/029,336	PACE, JOHN	
	Examiner	Art Unit	
	Mark Spisich	1744	

- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5, 9-12, 14-17 and 20-22 is/are rejected.
- 7) ☒ Claim(s) 3-5, 7, 8, 13, 18 and 19 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 December 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____

U.S. Patent and Trademark Office
PTOL-326 (Rev. 1-04)

Office Action Summary

Part of Paper No./Mail Date 02032004

*Exh. A to
Amendment filed
in 10/662,237
on 6/18/04*

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Art Unit: 1744

DETAILED ACTION***Drawings***

1. The drawings are objected to because the reference numeral in fig 1 which identifies the "micro-controller" should be #22 instead of #12 (because #12 is instead the brushhead portion and the controller is also #22 in the specification, eg, page 3, line 10). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

2. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. There is no prior mention or recitation of any "apparatus" to support the recitation thereof in claim 2 (line 6). Applicant should review the claims for any additional informalities.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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4. Claims 1,2,6,10,14,15,16,17 and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Hilscher et al (US 2002/0129454). Hilscher discloses a toothbrush comprising a handle portion (1) and a head portion (2) and further wherein the head portion includes a means for storing information which identifies the particular head and further including means acting between the head and handle to enable the information in the head to be read by device in the handle. Hilscher discloses numerous ways for accomplishing the cooperation of the head and handle, including the use of a "smart label" (19) (which would be a ROM memory device) and wherein the data thereon is transmitted to the handle by radio signals (wireless, eg claim 10) and further wherein operation of the brush is prevented unless a proper head portion is detected by the handle portion (paragraph 0010). Also, the mode of operation can be dictated by the information from the head read by the handle (paragraph 0039).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 9,11,12,20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hilscher et al (US 2002/0129454). The patent to Hilscher discloses the invention substantially as claimed and also discloses numerous ways in which the information of the brush can be transmitted or read by the handle (paragraph 0032).

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The particular manner of transmitting the information of the above-noted claims would be obvious to one of ordinary skill in view of the noted suggestion of Hilscher.

Allowable Subject Matter


7. Claims 3-5,7,8,13,18 and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Spisich whose telephone number is (571) 272-1278. The examiner can normally be reached on M-Th (6-3:30), Alternate Fri off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert J Warden can be reached on (571) 272-1281. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


MARK SPISICH
PRIMARY EXAMINER
GROUP 3400

Mark Spisich